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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91164764
Party	Defendant The Brinkmann Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BRINK'S NETWORK, INCORPORATED,

Opposer,

v.

THE BRINKMANN CORPORATION,

Applicant.

Opposition No. 91164764

**APPLICANT BRINKMANN'S OPPOSITION TO OPPOSER'S MOTION
FOR LEAVE TO FILE THIRD AMENDED NOTICE OF OPPOSITION**

Opposer Brink's Network, Incorporated ("Brink's Network") has brought a motion for leave to file a third amended Notice of Opposition ("Motion") to assert three additional trademark registrations against Applicant The Brinkmann Corporation ("Brinkmann"). Opposer's Motion should be denied because Opposer has been inexcusably dilatory in asserting the trademark registrations. However, if the Board grants Opposer's Motion, Applicant joins in Opposer's request to extend the discovery cut-off period by an additional sixty (60) days.

I.

STATEMENT OF FACTS

On January 17, 2003, Brinkmann filed the application at issue in this opposition, Ser. No. 76/483,115, for its trademark BRINKMANN in multiple classes to cover its then-existing lines of goods.

The application was published for opposition on October 5, 2004. Opposer

Brink's Network filed a Notice of Opposition on April 1, 2005. Opposer objected to registration of BRINKMANN only in connection with some, but less than all of the goods in International Class 9, namely, "home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets."

On May 13, 2009, Opposer filed a motion for leave to file a second amended Notice of Opposition. The second amended Notice of Opposition asserted the following grounds for opposition of Applicant Brinkmann's application: (1) likelihood of confusion under section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) with various marks incorporating BRINK'S; (2) dilution under section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), of various marks incorporating BRINK'S; (3) misuse of the federal registration symbol; and (4) fraudulent misrepresentation of material fact.

On August 7, 2009, the Board granted Opposer's motion for leave to file a second amended Notice of Opposition but struck Opposer's fraud claim from the notice of opposition because the Board found that the claim was legally insufficient and futile.

On June 4, 2010, Opposer filed the present motion for leave to file a third amended Notice of Opposition, which seeks to (1) delete the fraudulent misrepresentation of material fact claim (notwithstanding the fact that the Board already struck it from the second amended Notice of Opposition), (2) update the Notice of Opposition to reflect the recent change of name of one of Opposer's related companies and (3) assert three additional trademark registrations against Applicant Brinkmann. Opposer's Motion requests that the Board extend the discovery cut-off by sixty (60) days from the date of the Board's order granting or denying Opposer's Motion, in order to avoid any claim of prejudice by Applicant Brinkmann resulting from the granting of Opposer's Motion.

The first trademark registration that Opposer seeks to add to the third amended Notice of Opposition is Registration No. 2,330,884 for the mark BRINKS HOME SECURITY & Design, which registered on March 21, 2000.

The second trademark registration that Opposer seeks to add to the third amended Notice of Opposition is Registration No. 2,582,146 for the mark BRINKS, which registered on June 18, 2002.

The third trademark registration that Opposer seeks to add to the third amended Notice of Opposition is Registration No. 3,548,670 for the mark BRINKS & Design, which registered on December 23, 2008.

On June 8, 2010, Applicant Brinkmann's divided-out application for the mark BRINKMANN for the unopposed goods in International Classes 4, 6, 7, 8, 9, 11, 12, 21 and 30 was registered under Registration No. 3,797,964.

II.

DISCUSSION

A. **Applicant Does Not Oppose the Deletion of the Fraud Claim or the Update in Name Change of Opposer's Related Company, But Opposes the Addition of Opposer's Three Registrations**

Federal Rule of Civil Procedure 15(a) provides that a party may amend its pleading by "the court's leave" and that the "court should freely give leave when justice so requires." However, undue delay or prejudice to the opposing party may dictate otherwise. *See, e.g., Mitsui Foods, Inc. v. U.S.*, 867 F.2d 1401, 1403-04 (Fed. Cir. 1989) ("[T]he existence of such factors as 'undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, [or] futility of amendment' may justify the denial of a motion for leave to amend," quoting *Foman v. Davis*, 371 U.S. 178, 182 (1962)).

“The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. A long and unexplained delay in filing a motion to amend a pleading (when there is no question of newly discovered evidence) may render the amendment untimely.” TBMP § 507.02(a); *see also M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984) (plaintiff should plead any registrations it wishes to introduce as soon as possible after the omission, or newly issued registration, comes to plaintiff's attention); *Int'l Finance Corp. v. Bravo Co.*, 64 USPQ.2d 1597, 1604 (TTAB 2002) (motion denied where although discovery still open, movant provided no explanation for two-year delay in seeking to add new claim); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ.2d 1030, 1033 (TTAB 1996) (motion to add claim of fraud denied where petitioner was fully aware of all the facts it needed to add such claim over three years before filing motion to amend).

In the present proceeding, Applicant Brinkmann does not object to Opposer's request to delete the fraud claim pursuant to the Board's order and to update the change of name of one of its related companies because such changes to the Notice of Opposition do not unduly prejudice Applicant Brinkmann. However, Applicant Brinkmann does object to Opposer's attempt to assert three additional trademark registrations against Applicant. The first registration that Opposer seeks to add was registered in 2000, five years before Opposer filed the original Notice of Opposition. The second registration that Opposer seeks to add was registered in 2002, three years before Opposer filed the original Notice of Opposition. The third trademark registration that Opposer seeks to add was registered in 2008, well before Opposer filed its motions to file a first and second amended Notice of Opposition in 2009. *Notably, Opposer*

offers absolutely no explanation, much less an excuse, for the delay in asserting the three registrations. The reason for this is simple: Opposer has none. Opposer has no excuse for its undue delay in bringing up these registrations – only weeks before the discovery cut-off date – when it has been aware of these registrations for years.

The present proceeding has been pending since April 1, 2005, over five years. Applicant Brinkmann will be unduly prejudiced if Opposer is allowed to drag the proceeding out further by adding three completely new registrations for different goods to its Notice of Opposition. The undue prejudice to Applicant Brinkmann, coupled with Opposer's long and unexplained delay in asserting those registrations, dictates that Opposer's Motion be denied.

B. Applicant Continues to Object to Opposer's Dilution Claim

Applicant Brinkman objects to Opposer's Motion to the extent that the proposed third amended Notice of Opposition continues to include a claim for dilution under section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). Opposer Brink's Network only opposed the mark BRINKMANN for "home security systems" in class 9, even though Applicant Brinkmann filed a multi-class application *including many additional goods in class 9*. Now, Registration No. 3,797,964 has issued for the identical mark for goods in classes 4, 6, 7, 8, 11, 12, 21, 30, as well as in class 9, *which is the same class as those of the opposed goods*.

Applicant Brinkmann is mindful that the PTO treats each international class of goods or services in a multi-class application as a separate application. Applicant respectfully submits that this is clearly an erroneous approach when it comes to a dilution claim, as here. The simple fact in this case is that the identical mark BRINKMANN that is purportedly diluting Opposer's marks is now registered not only for goods in other classes, but for goods in the opposed class, class 9. As a simple matter of statutory interpretation, logic and common sense, an opposer cannot maintain a claim for dilution against a mark in a class in which it has willingly

allowed the mark to be registered. This is the antithesis of a dilution claim, which exists independent of the goods or services for the opposed mark. Opposer Brink's Network's claim for dilution, therefore, must fail as legally insufficient and should be stricken from the Notice of Opposition.

C. If Opposer's Motion is Granted, Additional Time for Discovery is Needed

Applicant Brinkmann opposes Opposer's Motion. However, if the Board grants the Motion, Applicant Brinkmann joins in Opposer's request to extend the discovery period by sixty (60) days from the date of the Board's order in order to alleviate the undue prejudice to Applicant Brinkmann of the imminent close of discovery.

III.

CONCLUSION

Opposer's motion to assert three completely different trademark registrations, if granted, is destined to cause the very prejudice and delay that our jurisprudence seeks to prevent. For all the reasons stated herein, Applicant Brinkmann respectfully requests that the Board deny Opposer's motion for leave to amend the Notice of Opposition to assert the three additional trademark registrations.

Dated: June 23, 2010



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CERTIFICATE OF SERVICE

This is to certify that I have this day, June 23, 2010, caused to be served a copy of the foregoing "Applicant Brinkmann's Opposition to Opposer's Motion for Leave to File Third Amended Notice of Opposition" by placing a copy in the United States Mail, postage pre-paid, addressed as follows: Alan S. Cooper, counsel for Opposer, at Howrey LLP, 1299 Pennsylvania Avenue, N.W., Washington, DC 20004.



Susan Hwang